



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,783	11/08/2001	Brad R. Lewis	30014200-1005	3403

26263 7590 05/16/2005

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

PAN, DANIEL H

ART UNIT	PAPER NUMBER
----------	--------------

2183

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/005,783	Applicant(s) LEWIS ET AL.	
	Examiner Daniel Pan	Art Unit 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 20, 26, 43, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

h

1. Claims 1-56 remain for examination.
2. Upon further review and based on the recent guideline from the Tech Center, the following includes "101" rejection. Since the guideline was not fully developed during the time of the first action, this is a non-final action to allow applicant a chance to respond. The amended claims 1-56 have overcome the art of record for teaching the combined details of every functional elements. However, claims 1-56 are subject to the pending condition of the "101" rejections to claims 1,2,20,26,43,53,54 .

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1,2,20,26,43,53,54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The reasons are given below :

4. As to claims 1,2,20, all the steps can be done by mental steps using pen and paper. For example, the step of storing data read and data write could be represented by a lookup table on paper (e.g. see the table in page 37 of applicant's specification), and the step of displaying a acyclic graph can be represented by a flow chart on paper. The step of executing the debug command can also represented by a flow diagram on paper. In fact, the evidence shows that the method could be implemented by software alone, or a program per se. Based on applicant's teaching in paragraph 00158 in the

Art Unit: 2183

specification, applicant taught the implementation could be done by "software", or "hardware and software", or in "hardware alone". It is not sure what it meant by implementation by "software". The implementation by "hardware and software", or in "hardware alone" is easily understood, but the implementation by "software" could just be a programming technique, or a programming listing. Therefore, it is for this reasons, the claimed method is given the broadest interpretation as being a programming method, and does not require a hardware, and it is therefore not tangible. The language of the claim raised a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art environment or machine which would result in practical application producing a concrete and tangible result to form the basis of subject matter under 35 U.S.C. 101.

5. As to claims 26,54, even though applicant has claimed "computer readable medium", based on applicant's teaching, the claimed medium is not necessarily require hardware because it could be done by "software" which is an intangible media (see the citation and explanation set forth above).

6. As to claim 43, claim 43 recites the storage of the data flow program in a memory. However, all the features could be implemented by software alone based on applicant's teaching (see the citations and explanations given above).

7. As to claim 53, claim 53 does not clearly recites that the "code" or the "data flow program" were stored into a memory. The partitioned memory areas are used for storing data read and write identifiers (see claim 53, lines 5-7). However, the R/W identifiers are not functional data. The example of functional data is a computer

executable program stored in a memory. Furthermore, although claim 53 also recites exaction of debug command (see last line), but it does not necessarily require hardware (see the explanation set forth above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 703 305 9696, or the new number 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 703 305 9712, or the new number 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 Century Strategic Plan

DANIEL H. PAN
PRIMARY EXAMINER
GROUP

